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REMARKS

Reconsideration is requested.

Claims 1-11, 14, 15, 18-21, and 23-33 are presented. Claims 12, 13, 16, 17, and 22 have been canceled. Claims 1, 14, 15, 20, 21, 23, 27, and 28 have been amended. New claim 33 has been added. Support for these amendments can be found at least at: page 3, line 22 through page 4, line 1; page 4, lines 5 - 8; page 4, lines 16 - 18; page 7, lines 2 - 4; page 7, lines 7 - 9; page 29, lines 20 - 22; and in the claims of Applicants' specification as filed. No new matter has been added.

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Rejection(s) Under 35 U.S.C. § 102(b)

Claims 1, 2, 12, 13 and 15-32 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Baird et al.* (US 3,901,236). Applicants have cancelled claims 12, 13, 16, 17, and 22 rendering this rejection moot as to these claims. Applicants submit that claims 1, 2, 15, 18 - 21, and 23 - 32 are not anticipated by *Baird et al.*

Baird et al. relates to composite structures *requiring* a prestretched elastomeric member and a rigidifying member secured in fixed relation to one another.¹ The composite structure so formed is strong enough to resist collapse in a direction parallel to the tensile forces acting upon the prestretched elastomeric member.²

With respect to independent claims 1, 15, and 20 of the Application, Applicants submit that the subject matter claimed therein patentably distinguishes over the document cited by the Examiner. Specifically, each independent claim of the Application recites, *inter alia*, an untensioned elastic. As discussed above, the document cited by the Examiner *requires* a prestretched or tensioned elastomeric member. As stated by the Court of Appeals for the Federal Circuit,

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim*.³

Such is not the case in this instance. Thus, Applicants submit that claims 1, 2, 15, 18 - 21, and 23 - 32 patentably distinguish over the document cited. Consequently, the Examiner's rejection(s) under 35 U.S.C. § 102(b) should be withdrawn.

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¹ U.S. Patent No. 4,908,247, issued March 13, 1990, to *Baird et al.*, column 8, line 65 through column 9, line 3.

² *Id.*

³ *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Cornell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

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Rejection(s) Under 35 U.S.C. § 103(a)

Baird et al.

Claims 1, 2, 12, 13 and 15 - 32 stand rejected under 35 U.S.C. § 103(a) as being obvious over *Baird et al.* (US 3,901,236). Applicants have cancelled claims 12, 13, 16, 17, and 22 rendering this rejection moot as to these claims. Applicants submit that claims 1, 2, 15, 18 - 21, and 23 - 32 are not obvious in view of *Baird et al.* In this rejection, the Examiner is apparently proposing that one of ordinary skill in the art would have been motivated to modify the composite structure of *Baird et al.* to arrive at Applicants' claimed invention. On the contrary, one of ordinary skill in the art would not have been so motivated.

It is well accepted that if a proposal for modifying the prior art in an effort to attain the claimed invention causes the art to become inoperable or destroy its intended function, then the requisite motivation to make the modification would not have existed.⁴ In this instance, *Baird et al.* requires that a prestretched elastomeric member and a rigidifying member be secured in fixed relation to one another so as to form a composite structure which is strong enough to resist collapse in a direction parallel to the tensile forces acting upon the prestretched elastomeric member. To begin even moving in the direction of Applicants' claimed invention, one of skill in the art would have to either (i) remove the rigidifying member from the prestretched elastomeric member, thus allowing the prestretched elastomeric member to become untensioned or (ii) form a composite structure by joining together an untensioned elastic and a rigidifying member. However, either modification would negate the *required* construction of *Baird et al.*: namely, a composite structure having a prestretched elastomeric member and a rigidifying member secured in fixed relation to one another. Any such modification would thus cause the invention of *Baird et al.* to become inoperable or destroy its intended function. Consequently, Applicants submit that claims 1, 2, 15, 18 - 21, and 23 - 32 are not obvious in view of *Baird et al.*

⁴ See *In re Fitch*, 972 F.2d 1260, 1265 n.12, 23 U.S.P.Q.2d 1780, 1783 n.12 (Fed. Cir. 1992) ("A proposed modification [is] inappropriate for an obviousness inquiry when the modification render[s] the prior art reference inoperable for its intended purpose."). See also MPEP § 2143.01 ("If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification."), Rev. 1, Feb. 2003.

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Baird et al. in view of any one of Reiter, Lancaster et al. or Coles et al.

Claims 1-13 and 15-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Baird et al.* in view of *Reiter* (US 4,543,154), *Lancaster et al.* (US 4,917,682), or *Coles et al.* (EP 0650714 A1). Applicants have cancelled claims 12, 13, 16, 17, and 22 rendering this rejection moot as to these claims. Applicants submit that claims 1 - 11, 15, 18 - 21, and 23 - 32 are not obvious in view of *Baird et al.*, in view of *Reiter, Lancaster et al.*, or *Coles et al.*

The deficiencies of *Baird et al.* have been discussed previously and need not be discussed again here. Apparently the Examiner cites *Reiter, Lancaster et al.* or *Coles et al.* in an attempt to rectify the deficiencies of *Baird et al.* However, the teachings of any or all of *Reiter, Lancaster et al.* or *Coles et al.* fail to prevent *Baird et al.* from becoming inoperable or destroying its intended function. Even with the teachings of *Reiter, Lancaster et al.* or *Coles et al.*, the intended function of *Baird et al.* would become inoperable or destroyed if an untensioned elastic material were affixed. Consequently, Applicants submit that claims 1 - 11, 15, 18 - 21, and 23 - 32 are patentable over *Baird et al.* in view of *Reiter, Lancaster et al.*, or *Coles et al.*⁵

Baird et al. in view of any one of Reiter, Lancaster et al. or Coles et al. taken further with either Roessler or Wideman

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Baird et al.* in view of *Reiter, Lancaster et al.*, or *Coles et al.*, and further taken with any one of *Roessler et al.* (US 5,743,994) or *Wideman* (US 4,606,964).

The deficiencies of *Baird et al.* have been discussed previously and need not be discussed again here. Apparently the Examiner cites *Reiter, Lancaster et al.* or *Coles et al.* and further taken with any one of *Roessler et al.* or *Wideman* in an attempt to rectify the

⁵ See *In re Ratti*, 270 F.2d 810, 813, 123 U.S.P.Q. 349, 352 (C.C.P.A. 1959) (holding the suggested combination of references improper under § 103 because it "would require a substantial reconstruction and redesign of the elements shown in [a prior art reference] as well as a change in the basic principles under which [that reference's] construction was designed to operate."). See also MPEP §§ 2143 ("If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.") and 2145 ("However, the claimed combination cannot

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deficiencies of *Baird et al.* However, the teachings of any or all of *Reiter, Lancaster et al.* or *Coles et al.* and further taken with any one of *Roessler et al.* or *Wideman* fail to prevent *Baird et al.* from becoming inoperable or destroying its intended function. Even with the teachings of *Reiter, Lancaster et al.* or *Coles et al.* and further taken with any one of *Roessler et al.* or *Wideman*, the intended function of *Baird et al.* would become inoperable or destroyed if an untensioned elastic material were affixed. Consequently, Applicants submit that claim 14 is patentable over *Baird et al.* in view of *Reiter, Lancaster et al.*, or *Coles et al.* and further taken with any one of *Roessler et al.* or *Wideman*.⁶

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change the principle of operation of the primary reference or render the reference inoperable for its intended purpose."), Rev. 1, Feb. 2003.

⁶ *Id.*

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CONCLUSION

For at least any or all of the foregoing remarks, the foregoing rejections should be withdrawn. Consequently, Applicants submit that the Application, including Claims 1-11, 14, 15, 18-21, and 23-33, is in condition for allowance and that action is earnestly solicited.


In the event the Examiner has any questions concerning this Response, the Examiner is invited to contact Attorney for Applicants at the telephone number listed below.

The Commissioner is hereby authorized to charge any fee(s) which may be required for this Response to Kimberly-Clark Worldwide, Inc., Deposit Account No. 11-0875.

Respectfully submitted,

T.H. Roessler, et al.

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David J. Arteman
Registration No. 44,512
Attorney for Applicants

Kimberly-Clark Worldwide, Inc.
401 N. Lake St.
P.O. Box 349
Neenah, WI 54957-0349
Tel: 920.721.3016
Fax: 920.721.3129